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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of Timothy P. Croughan

Examiner Clardy, S.

Serial No. 09/830,194

International Filing Date 05 November 1999

Group 1616

35 U.S.C. § 371 Date 23 April 2001

For: Herbicide Resistant Rice

Atty. File 98A9-US Croughan

Commissioner for Patents  
Washington, D.C. 20231

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(1) RENEWED REQUEST FOR WITHDRAWAL AND  
CLARIFICATION OF RESTRICTION REQUIREMENT

and

(2) PROVISIONAL ELECTION WITH TRAVERSE  
IN RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir or Madam:

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CERTIFICATE

I hereby certify that this Renewed Request and Provisional Election is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, D.C. 20231 on July 15, 2002.

John H. Runnels  
Registration No. 33,451  
July 15, 2002

This paper is submitted in response to the Restriction Requirement that was mailed on March 15, 2002. A response to that Restriction Requirement appears below. But first Applicant will explain why that Restriction Requirement should be clarified and withdrawn, and why no fee for any extension of time should be due in connection with the present paper.

**I. Applicant Has Diligently Sought Clarification and Correction  
of the March 15, 2002 Restriction Requirement, but to date  
the Office Has Not Responded.**

Applicant respectfully renews his request that the restriction requirement mailed on March 15, 2002 be withdrawn and clarified. The March 15, 2002 restriction requirement referred incorrectly to which Claims are properly pending in this application.

Applicant has diligently sought to have the Office correct the March 15, 2002 Action, but to date the Office has not done so. The undersigned transmitted a Request for Withdrawal to the Office by facsimile on March 21, 2002, just six days after the restriction requirement was originally mailed (and only two days after it had been received by the undersigned). Because no response to this Request had been received from the Office, the March 21, 2002 Request for Withdrawal was re-transmitted by facsimile on June 4, 2002.

In addition, the undersigned has either spoken with the Examiner, or left voice mail messages for the Examiner, or both, on the following dates, to inquire as to the status of the pending Request for Withdrawal: June 4, July 3, July 8, and July 12.

As no response has been received from the Office to the Applicant's timely Request for Withdrawal, and as the day the present paper is being mailed marks the end of the period for a three-month extension of time to respond to the March 15, 2002 restriction requirement, the present paper is being filed now from an abundance of caution.

In view of the Office's error in identifying which Claims are pending in this application (as discussed further below); and in view of the Applicant's diligence in attempting to have the Office clarify and correct this error, it is respectfully submitted that the present paper should be treated as a proper and timely response to the March 15, 2002 Action, and that no fee for any extension of time should be imposed. From an abundance of caution, should the Office determine that any extension of time is required, the Office is

requested to treat this paper as a petition for the full extension of time required. Should the Office determine that a fee for extension of time is due, the Office is respectfully referred to the general Deposit Account Authorization that was filed with the national stage papers for this application. If any fee for an extension of time should be charged initially as a clerical matter, before this paper has been reviewed by the Examiner, for the same reasons the Office is respectfully requested to refund any such fee by credit to Deposit Account No. 20-0096.

**II. The Claims that Are Properly Pending in this Application  
Are Claims 1-15, 31-38, 54-61, and 82-128,  
Not the Claims Identified in the March 15, 2002 Action.**

The international application was originally filed with Claims 1-81. During the international phase, the application was amended to contain Claims 1-15, 31-38, 54-73, and 75-128.

Upon entry into the United States national stage, by Preliminary Amendment dated April 23, 2001, the Office was requested to amend the Claims: (1) first, to conform to the amendments made during the international stage, by entering the annexes to the International Preliminary Examination Report (copies of which were enclosed); and (2) second, by then canceling Claims 62-73 and 75-81. See April 23, 2001 Preliminary Amendment, pp. 1-2.

Therefore, the Claims that are properly pending in this application are 1-15, 31-38, 54-61, and 82-128, as was clearly pointed out on page 3 of the April 23, 2001 amendment. Further, the filing fees that were paid upon entering the national stage conformed to these claims, not to the claims that were identified in the restriction requirement.

It appears that the claims identified in the restriction requirement, 1-61 and 74, resulted from a clerical error -- namely, overlooking the entry of the amendments reflected in the international annexes prior to making the other amendments requested in the preliminary amendment.

Accordingly, the Office is respectfully requested to: (1) withdraw the March 15, 2002 restriction requirement; (2) enter the amendments to the specification and claims reflected in the international annexes; and (3) then enter the other amendments requested in the April 23, 2001 preliminary amendment.

### **III. Traversal of Restriction Requirement**

The March 15, 2002 Restriction Requirement identified three Groups of Claims. Applicant respectfully traverses the restriction requirement for the following reasons.

No Claims within Group III are properly pending in this application. The March 15, 2002 Action identified Group III as containing a single Claim, Claim 74. As discussed in the prior section, Claim 74 is not properly pending in this application. Any consideration of Claim 74 is therefore moot. The Office's identification of a separate Group III should therefore be withdrawn. (Applicant does not concede that restriction would be proper with respect to Group III had Claim 74 not been canceled. Rather, Applicant's point is that the Office has never had proper reason to consider Claim 74, whether in the context of a restriction requirement or otherwise. Applicant reserves the right to argue at a later date, should the need arise, that Group III should not have been restricted from Groups I and II on the merits.)

As the March 15, 2002 Action correctly recognized, unity of invention is the governing standard in this United States national stage of a PCT international application, not the "usual" rules governing restriction in a directly-filed United States non-provisional patent application.

The sole reason given in the March 15, 2002 Action for asserting that unity of invention was lacking between Groups I and II was that "the subject matter common to the claims consists merely in resistance of a plant to the action of a herbicide, a feature which is well known in the art. Thus the claims are not so linked as to form a general inventive concept as required by PCT Rule 13.1."

In other words, if Applicant understands the Office's position correctly, the Office is asserting that a lack of novelty for the plants of Group I justifies an assertion of lack of unity of invention between Groups I and II. On the other hand, if the plants of Group I are novel -- which in fact they are -- then the basis for asserting lack of unity is gone.

The Office did not cite a single reference to support its assertion of lack of unity, not one reference that might tend to show that the plants of Group I lack novelty.

It is respectfully submitted that, as examination of the Claims on the merits will show, the plants of Group I are in fact both novel and nonobvious. It then follows that the Office's basis for asserting lack of unity should be withdrawn.

In particular, the Office's characterization of the Claims of Groups I and II is incorrect in a subtle but significant way. The Office said that the common subject matter "consists merely in resistance of a plant to the action of a herbicide, a feature which is well known in the art." The Claims do not, however, refer generically to resistance of "a" plant to "a" herbicide; nor do the Claims refer to herbicide resistant rice plants generically. Rather, they refer to herbicide resistance rice plants that are derived from at least one of several specifically-identified herbicide resistant rice lines, samples of which have been deposited with ATCC (ATCC accession numbers PTA-904, PTA-905, 203419, 203420, etc.), wherein the rice plants have the herbicide resistance characteristics of at least one of those ATCC-deposited plants. There is no claim limitation directed to herbicide resistance in the abstract, as the Office's rationale appears to suggest.

In order to show that the claimed inventions were anticipated, and therefore to justify a finding of lack of unity of invention, the Office would need to demonstrate not merely that herbicide resistant plants were known in the art, nor even that herbicide resistant rice plants were known in the art. Rather, the Office would need to demonstrate that the specifically-identified, ATCC-deposited herbicide resistant rice plants recited in the Claims are anticipated or are obvious in light of prior art. The Office has not done so. It is respectfully submitted that the claimed rice plants are, in fact, both novel and nonobvious. The Office has not presented even a *prima facie* case to the contrary.

It is respectfully submitted that the restriction requirement, and the assertion of lack of unity of invention, should be withdrawn.

#### **IV. Provisional Election**

**A. Restriction Requirement.** From an abundance of caution, Applicant provisionally elects with traverse Group I, which the Office identified as including Claims 1-37.

For the reasons previously given, it is respectfully submitted that the restriction requirement should be withdrawn. Strictly in the alternative, should the Office maintain the restriction requirement, while correcting the identification of which Claims are fact pending in the application, then it is respectfully submitted that the following re-grouping of the Claims would appear to be consistent with the Office's original grouping of the Claims for restriction purposes. Applicant emphasizes that Applicant does not advocate this grouping of the Claims as reflecting a proper restriction requirement. Applicant merely observes that this grouping would appear to be consistent with the Office's previous grouping of the Claims:

Group I, Claims 1-15, 31-37, and 82-111, drawn to a herbicide resistant rice plant.

Group II, Claims 38, 54-61, and 112-128, drawn to a process for controlling weeds in the vicinity of a herbicide resistant rice plant.

If the Office re-grouped the Claims in the above manner, then Applicant would provisionally elect with traverse Group I, i.e., Claims 1-15, 31-37, and 82-111. The traversal of this alternative restriction requirement would be for the same reasons as given in Section III above.

#### **B. Election of Species Requirement.**

The Office also required an election of species respecting the herbicides to which the rice plants are resistant, or which are used to control weeds in the vicinity of the rice plants.

Applicant provisionally elects the plants and processes as recited, with reference to the herbicide imazethapyr. Applicant is unsure how best to identify which Claims read on the provisionally-elected species, in view of the treatment of the Claims to date.

Referring to the Claims that are properly pending in this application, following the complete entry of the April 23, 2001 Preliminary Amendment, and referring to the alternate grouping of the Claims suggested at the end of the preceding section (Group I = Claims 1-15, 31-37, and 82-111; Group II = Claims 38, 54-61, and 112-128), the following Claims read on

rice plants that are resistant to imazethapyr at normally inhibitory levels, or on processes to control weeds in the vicinity of such plants by applying the herbicide imazethapyr:

Group I -- all Claims = Claims 1-15, 31-37, 82-111

Group II -- Claims 38, 54-60, 112-127

#### **V. Miscellaneous -- The Priority Claim**

On another matter, Applicant notes that the March 15, 2002 "Office Action Summary," form PTO-326, particularly boxes 13 and 14, incorrectly refers to the priority that is claimed by this application. Domestic priority has in fact been claimed under 35 U.S.C. § 119(e). There has been no claim for foreign priority under 35 U.S.C. § 119(a)-(d). The Office is respectfully requested to correct this clerical error in the next communication concerning this application. See the April 23, 2001 Preliminary Amendment, at the top of page 2, amending the Specification. See also M.P.E.P. § 1893.03(c), under the heading "Priority Claim under 35 U.S.C. 119(e), or 120 and 365(c)."

#### **VI. Conclusion**

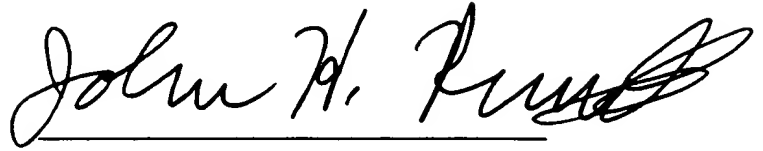
No fee for any extension of time should be due. If a fee for extension of time has been charged on account of the present paper, then a refund of that fee by credit to Deposit Account 20-0096 is respectfully requested.

The Office should correct its records to reflect the Claims that are properly pending in this application, in accordance with the Preliminary Amendment that was submitted contemporaneously with the United States national stage papers.

The restriction requirement should be withdrawn, and all pending Claims should be examined on their merits.

Allowance of Claims 1-15, 31-38, 54-61, and 82-128 at an early date is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, reading "John H. Runnels". The signature is written in a cursive style with a horizontal line underneath the name.

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July 15, 2002